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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,012	07/10/2003	Alexander N. Glazer	B00-016-3	3078

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EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1656

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/617,012	Applicant(s) GLAZER ET AL.	
	Examiner Chih-Min Kam	Art Unit 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 8-14 is/are allowed.
- 6) ☒ Claim(s) 5-7 and 15-18 is/are rejected.
- 7) ☒ Claim(s) 19-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 1-22 are pending.

Applicants' amendment filed June 7, 2006 is acknowledged. Applicants' response has been fully considered. Claims 1, 10 and 11 have been amended. Therefore, claims 1-22 are examined.

### **Withdrawn Claim Rejections - 35 USC § 112**

2. The previous rejection of claims 10 and 11 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicants' amendment to the claims, and applicants' response at page 5 in the amendment filed June 7, 2006.

### **Withdrawn Claim Rejections - 35 USC § 102**

3. The previous rejection of claims 1-4, 6, 8-11, 14, 15 and 17 under 35 U.S.C. 102(b) as being anticipated by Colleen Mary Toole (Dissertation; UMI microfilm 9839498, available on December 14, 1998), is withdrawn in view of applicants' amendment to the claims, and applicants' response at pages 5-6 in the amendment filed June 7, 2006.

### **Withdrawn Claim Rejections-Obviousness Type Double Patenting**

4. The previous rejection of claims 1-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U. S. Patent 6,649,376, is withdrawn in view of applicants' submission of a terminal disclaimer, and applicants' response at page 6 in the amendment filed June 7, 2006.

### ***New Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 15-18 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11-14 of U.S. Patent 6,649,376, a double patenting rejection. Both sets of claims are directed to a method of making the fusion protein comprising a functional displayed domain and a functional phycobiliprotein domain incorporated in a functional oligomeric phycobiliprotein; and a method for isolating a functional displayed domain from the fusion protein.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 5 and 7 are indefinite because the claim recites the composition further comprising a specific binding moiety (claim 5) or a protease cleavage site between the displayed domain or the phycobiliprotein domain (claim 7), while claim 1 indicates the oligomeric phycobiliprotein further comprises a specific binding moiety or a protease cleavage site between the displayed domain or the phycobiliprotein domain. It is not clear whether the specific binding moiety or the protease cleavage site in the composition is covalently bonded to the fusion protein in the same way as in the oligomeric phycobiliprotein.

8. Claim 6 is indefinite because the claim recites the composition further comprising a linker peptide between the displayed domain or the phycobiliprotein domain, it is not clear whether this linker peptide contains a protease cleavage site or not.

#### ***Claim Objections***

9. Claims 19-22 are objected to because the claim depends from a rejected claim.

#### ***Conclusion***

10. Claims 5-7 and 15-18 are rejected; and claims 19-22 are objected to. It appears that claims 1-4 and 8-14 are free of art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.  
Primary Patent Examiner



primary

**CHIH-MIN KAM**  
**PRIMARY PATENT EXAMINER**

CMK

August 10, 2006